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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/991,894

11/13/2001

Scott Lascelles

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INTELLECTUAL PROPERTY SECTION
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EXAMINER

MALHOTRA, SANJEEV

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

08/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/991,894	Applicant(s) LASCELLES ET AL.	
	Examiner SANJEEV MALHOTRA	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 and 18-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

RCE Acknowledgement

and Status of Claims

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's RCE submission filed on July 14, 2009 has been entered.
2. This Office Action is a Restriction Election in response to the RCE filed on July 14, 2009 for the original application filed on November 13, 2001 and titled: "On-line Balance Transfers". Claims 1-16 and 18-24 are pending, and are now being examined in this application.

Claim Restrictions

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 USC 121:

Invention (Group) I: Claims 1-13 are directed to a computer implemented method for online transfer of a balance from a first credit account associated with an account holder to a second credit account associated with the account holder comprising of receiving at a computer a balance transfer request for transferring a balance from the first credit account to the second credit account; and obtaining account data associated with the first credit account, said account data comprising at least an identifier for a first financial institution with which the first credit account is held; and determining with a business logic server, using the account data associated with the first credit account, whether the first financial institution with which the first credit account is held is related to a second financial institution with which the second credit account is held; and displaying at least a portion of said account data associated with the first credit account to the account holder in the event it is determined that the first financial institution is not the same as or affiliated with the second financial institution; and providing to the account holder a balance transfer request display, the balance transfer display comprising a data entry field; and in the event it is determined that the first financial institution is not the same as or affiliated with the second financial institution, populating the data entry field with at least one element of said account data associated with the first credit account, drawn to class 705, subclass 39.

Invention (Group) II: Claims 14-15 are directed to a system for online transfer of a balance comprising of a computer system configured to obtain account data associated with the first credit account, said account data comprising at least information identifying

a first financial institution with which the first credit account is held; and determine whether the online balance transfer request meets at least one eligibility requirement, the at least one eligibility requirement comprising a requirement that a-the first financial institution with which the first credit account is held is not related to a second financial institution with which the second credit account is held; and a network connection associated with the computer system and configured to enable the computer system to receive data transmissions from and send data transmissions to the account holder; and wherein said computer system comprises two or more computers, drawn to class 705, subclass 21.

Invention (Group) III: Claims 16-24 are directed to a computer program product for online transfer of a balance from a first credit account associated with an account holder to a second credit account associated with the account holder in response to receiving an online balance transfer request originated from the account holder, the computer program product being embodied in a computer readable medium and comprising computer instructions for determining whether the online balance transfer request meets at least one eligibility requirement, the at least one eligibility requirement comprising a requirement that-a the first financial institution with which the first credit account is held is not related to a second financial institution with which the second credit account is held; and process the online balance transfer request if all eligibility requirements are met and, otherwise, not process the online balance transfer request; and wherein the computer readable medium further comprises instructions for receiving from the account

holder an indication that the account holder is interested in transferring a balance to the second credit account; wherein obtaining account data is performed in response to receiving said indication, drawn to class 705, subclass 17.

4. Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination Group I consists of method claims, while Groups II and III have separate utility as system claims and product (apparatus) claims as explained above, and because Group II consists of a system group of claims that can be practiced by telephone, facsimile and hand (manually). See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

5. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election

shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Based on the foregoing analysis, it is asserted that each group of invention would require separate search of its own thereby imposing undue burden on the examiner. Because these inventions in Groups I to III are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required, because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Examiner notes that in the instant case, Group I, II and III (independent claims and dependent claims in combination) contain overlapping claim elements **and** distinct claim elements. Therefore, the claimed inventions, despite overlapping claim elements, are still independent and distinct.

Should the Applicants want to present arguments for examination of Groups I and II together, for example, Examiner notes that Groups I (method claims) and Group II (system claims) can be requested to be examined together as one invention, if the Applicants expressly state on the record in response to this Office Action and after each amendment hereafter that the two groups of inventions are not patentably distinct, and also make appropriate amendments in these groups to remove the distinct claim elements. However, until the Applicants make this statement on the record and remove the distinct claim elements, this restriction requirement is deemed to be proper.

No telephone interview was conducted due to the complexity of the restriction requirement and since the examiner knows from past experience that an election will not be made by telephone. (see MPEP § 812.01)

7. The applicant is advised that a reply to this requirement must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.43). Because these Inventions in Groups I--III are distinct as explained above, it is asserted that each group of invention would require a separate search of its own imposing undue burden on the examiner.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48 (b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48 (b) and by the fee required under 37 CFR 1.17.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjeev Malhotra whose telephone number is 571-272-7292. The examiner can normally be reached on Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sanjeev Malhotra/
SANJEEV MALHOTRA, Patent Examiner
21 AUGUST, 2009